



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,820	07/02/2003	Robert Smyler	18634.00	3009

37833 7590 02/15/2005

LITMAN LAW OFFICES, LTD.  
P.O. BOX 15035 CRYSTAL CITY STATION  
ARLINGTON, VA 22215

EXAMINER
----------

VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
----------	--------------

3618

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/611,820

Applicant(s)

SMYLER, ROBERT

Examiner

Frank Vanaman

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/2/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **Drawings**

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the wheel bearings (claim 15) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Note that any item deemed to be of such importance to the definition of the invention that it appears in a claim recitation should be illustrated in the drawings.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Rejections - 35 USC § 112**

2. Claims 4-14 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, lines 13-15, it is not clear whether or not applicant is attempting to incorporate method limitations into an apparatus claim, with the result being an hybrid claim of indefinite scope. Note, additionally; claim 5, lines 32-37; claim 11, lines 11-13; claim 18, lines 13-15; claim 19, lines 32-37. In claim 5, lines 23-25, the dual recitation of an upper portion is confusing. Note later in this claim (line 29) and other dependent claims (e.g., claim 10), the recitation of "said lower

Art Unit: 3618

portion" which lacks antecedent basis, as such it appears that one of the 'upper portions' should read –lower portion–. Also see claim 19, lines 23-25 where a similar condition obtains. Claim 20 contains a number of terms lacking a clear antecedent basis in claim 15 from which it currently depends. Note that it appears as though claim 20 should depend from claim 19 in view of the recitation of the brake connecting frames. As regards claims currently rejected under 35 USC §112, second paragraph, please note that rejections under 35 USC §102 and 103 should not be based upon considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims when the claims are not definite. See *In re Steele* 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become anticipated or obvious, but rather the claim becomes indefinite. See *In re Wilson* 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As such the currently pending claims may be subject to prior art rejections not set forth herein upon the clarification of the claim language.

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (US 6,328,317). Benoit teaches a skate having a boot (2) with a sole (3) which mounts to a channel shaped frame (5) extending lengthwise with respect to the sole, having an upper wall (4a) and side walls (10a) with toe and heel attachment plates (4, 11), opposing walls of the frame forming a toe portion which extends forward and downward from the toe, opposing walls of the frame forming a heel portion which extends rearward and downward from the heel; front, rear and intermediate wheels (6,

Art Unit: 3618

all) mounted on front, rear and intermediate axles (16) mounted to supports on the frame, including bearing portions (15), the front axle being spaced downwardly and forwardly of the toe region (see figure 2), the rear axle being located downwardly and below the heel portion, the frame including upper toe and heel pieces (12, both) mounted between the side walls and extending upwardly from a most proximal wheel periphery portion. The reference to Benoit fails to specifically teach the use of toe and heel pads at the toe and heel mounting locations. Such pads are very well known for use in the skating arts for both height adjustment and shock absorption (depending upon the material employed) and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate of Benoit with toe and heel pads at the toe and heel mounting portions for the purpose of either (a) adjusting the height or (b) shock absorption.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit in view of Kronymak, Jr. (US 5,584,491, cited by applicant). The reference to Benoit is discussed above and fails to teach the provision of a braking system as set forth in claim 18. Kronymak, Jr. teaches a common braking arrangement for use with skates, including a hand grip brake portion (3) including a grip (38), a lever (40) pivotally connected to a control body (42) and a heel mounted brake assembly (4) having connecting frame members (30) connected to the rearward portion of a skate frame (figure 4), further including a brake pad (34) and an actuator cable in a sheath (26, 28) connecting the hand grip and heel brake portions. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the braking device as taught by Kronymak, Jr., to the skate of Benoit for the purpose of allowing a user to easily stop or slow down without having to tilt the skate.

6. Claims 1-3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit in view of Ellis et al (US 6,131,921). Benoit teaches a skate having a boot (2) with a sole (3) which mounts to a channel shaped frame (5) extending lengthwise with respect to the sole, having an upper wall (4a) and side walls (10a) with toe and

Art Unit: 3618

heel attachment plates (4, 11), opposing walls of the frame forming a toe portion which extends forward and downward from the toe, opposing walls of the frame forming a heel portion which extends rearward and downward from the heel; front and rear wheels (6, all) mounted on front and rear axles (16) mounted to supports on the frame, including bearing portions (15), the front axle being spaced downwardly and forwardly of the toe region (see figure 2), the rear axle being located downwardly and below the heel portion, the frame including upper toe and heel pieces (12, both) mounted between the side walls and extending upwardly from a most proximal wheel periphery portion and at least one stiffener (13) mounted between the channel side walls, having an arch-shape, and connected to both walls at respective ends thereof. The reference to Benoit fails to specifically teach the use of toe and heel pads at the toe and heel mounting locations. Such pads are very well known for use in the skating arts for both height adjustment and shock absorption (depending upon the material employed) and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate of Benoit with toe and heel pads at the toe and heel mounting portions for the purpose of either (a) adjusting the height or (b) shock absorption. As regards the wheel diameters, it is well known to employ wheels having diameters appropriate to the frame size and to the envisioned terrain the user will be riding over, and as such, it would have been obvious to one of ordinary skill in the art at the time of the invention to use wheels having a diameter of 80-90 millimeters for the purpose of accommodating a desired terrain and frame size.

The reference to Benoit fails to teach the use of only two wheels. Ellis et al. teach a skating system wherein a skate having in-line wheels may be provided with four wheels (figure 1) or with two wheels (figure 7, 8a, 8b). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate taught by Benoit with only front and rear wheels as taught by Ellis et al., for the purpose of adjusting the ground engaging properties of the skate.

7. Claims 4, 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit in view of Ellis et al. and Kronyak, Jr. The reference to Benoit as modified

Art Unit: 3618

by Ellis et al. is discussed above and fails to teach the provision of a braking system. Kronymak, Jr. teaches a common braking arrangement for use with skates, including a hand grip brake portion (3) including a grip (38), a lever (40) pivotally connected (see figure 3) to a control body (42) and a heel mounted brake assembly (4) having connecting frame members (30) connected to the rearward portion of a skate frame (figure 4), further including a brake pad (34) and an actuator cable in a sheath (26, 28) connecting the hand grip and heel brake portions, wherein the hand lever is provided with a cable connector (figure 3, proximate the end of 28), the brake control body (42) additionally including a sheath connector and stop (proximate the end of 26, figure 3). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the braking device as taught by Kronymak, Jr., to the skate of Benoit as modified by Ellis et al. for the purpose of allowing a user to easily stop or slow down without having to tilt the skate. As regards claim 13, the references to Benoit, Ellis et al. and Kronymak fail to specifically teach the use of threaded apertures to accommodate mounting screws for the brake assembly, however the use of screws and threaded apertures is very old and very well known, and it would have been obvious to one of ordinary skill in the art at the time of the invention to provide threaded apertures in the frame and mating screws for connection thereto, for the purpose of providing a quickly removable mounting for the braking assembly, allowing simplified maintenance.

### **Allowable Subject Matter**

8. Claims 5-10, 12, 14, 19 and 20 (assumed dependent from claim 19), as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McMahan (US 3,901,520), Brennan (US 3,999,772), Moldenhauer (US 5,411,276), Wilhelm, III (US 5,743,540), Koester, Jr., (US 5,791,664),

Art Unit: 3618

Kubelka (US 6,443,463), Olson et al. (EP 0 551 704), Borel (EP 0 891 795), and Baggio et al. (EP 0 848 971) teach skate structures of pertinence.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

A response to this action should be mailed to:


Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450,

Or faxed to one of the following fax servers:

Regular Communications/Amendments: 703-872-9326  
After Final Amendments: 703-872-9327  
Customer Service Communications: 703-872-9325

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**F. VANAMAN**  
**Primary Examiner**  
**Art Unit 3618**

  
2/10/05